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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,367	06/05/2001	Paul E. Young	689290-64	5688

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EXAMINER

SMITH, CAROLYN L

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/873,367

Applicant(s)

YOUNG ET AL.

Examiner

Carolyn L Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 and 44-52 is/are pending in the application.
- 4a) Of the above claim(s) 6-42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 44-52 is/are rejected.
- 7) ☒ Claim(s) 1-5, 44-50 and 52 is/are objected to.
- 8) ☒ Claim(s) 1-42 and 44-52 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11202003.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's amendments and remarks, filed 10/20/03, are acknowledged. Amended claims 1, 2, 5, and 45-52 are acknowledged. To clarify from the previous office action, cancellation of misnumbered claim 44 is currently numbered claim 43 (cancelled).

Applicant's arguments, filed 10/20/03, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from the previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 1-5 and 44-52 are herein under examination.

#### ***Claim Objections***

Claims 1-5, 44-50, and 52 are objected to due to the inclusion of subject matter which has been non-elected due to a restriction requirement and therefore withdrawn from consideration. The non-elected subject matter in claim 51 is summarized as follows: Claim 1-5, 44-50, and 52 contain sequences, such as sequences other than SEQ ID NO: 16, 87, 453, 462, 468, 651, 865, 1015, 1027, and 1051, which are non-elected subject matter. Removal of non-elected subject matter is requested.

***Claim Rejections – 35 U.S.C. 112, first paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**LACK OF WRITTEN DESCRIPTION**

The rejection of claims 1-5, 45-50, and 52 is maintained under 35 U.S.C. 112 and newly applied to claim 44 (due to amending of the previously cancelled claim number 44), first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time of the invention was filed, had possession of the claimed invention.

The specification discloses SEQ ID NO: 16, 87, 453, 462, 468, 651, 865, 1015, 1027, and 1051 which correspond to nucleic acid sequences. SEQ ID NO: 16, 87, 453, 462, 468, 651, 865, 1015, 1027, and 1051 and their full complements meet the written description provisions of 35 U.S.C. 112, first paragraph. However, due to the open claim language of “comprising a nucleotide sequence encoding the same protein as a gene” in claims 1 and 52, these claims encompass sequences which do not meet the written description provision of 35 U.S.C. 112, first paragraph. It is noted that “a sequence that is at least 95% identical thereto” (as stated in claim 44) encompasses a sequence with a SEQ ID NO, as stated above, plus up to 5% of additional sequence on either end which does not meet the written description provision of 35 U.S.C. 112, first paragraph. The specification provides insufficient written description to support the genus encompassed by these claims.

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Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

With the exception of SEQ ID NO: 16, 87, 453, 462, 468, 651, 865, 1015, 1027, and 1051, the skilled artisan cannot envision the detailed chemical structure of the encompassed polynucleotides and/or proteins, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The nucleic acid itself is required. See Fiers v. Revel, 25 USPQ2d 1601, 1606 (CAFC 1993) and Amgen Inc. V. Chugai Pharmaceutical Co. Ltd., 18 USPQ2d 1016. In Fiddes v. Baird, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence.

Finally, University of California v. Eli Lilly and Co., 43 USPQ2d 1398, 1404, 1405 held that:

...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." Lockwood, 107 F.3d at 1572, 41 USPQ2d at 1966.

Therefore, only SEQ ID NO: 16, 87, 453, 462, 468, 651, 865, 1015, 1027, and 1051 and their full length complements, but not the full breadth of the claims meet the written description provision of 35 USC 112, first paragraph. The species specifically disclosed are not representative of the genus because the genus is highly variant. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 USC 112 is severable from its enablement provision. (See page 1115.)

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Applicants state that they have amended the claims to read on a polynucleotide encoding the same protein as a gene. This is acknowledged as there is written support for this phrase as far as pertaining to SEQ ID NO: 16, 87, 453, 462, 468, 651, 865, 1015, 1027, and 1051. However, the amendments to claims 1 and 52 as well as the arguments presented by the Applicants do not specifically address the written description rejection, as reiterated and added upon above, and is therefore found unpersuasive.

***Claim Rejections – 35 U.S.C. 112, first paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized in *Ex parte Forman*, 230 USPQ 546 (BPAI 1986) and reiterated by the Court of Appeals in *In re Wands*, 8 USPQ2d 1400 at 1404 (CAFC 1988). The factors to be considered in determining whether undue experimentation is required include: (1) the quantity of experimentation necessary, (2) the amount or direction presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. The Board also stated that although the level of the skill in molecular biology is high, the results of experiments in genetic engineering are unpredictable. While all of these factors are considered, a sufficient amount for a *prima facie* case are discussed below.

LACK OF ENABLEMENT

Claims 1-5 and 44-52 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the claimed invention.

The sequences selected in these methods include sequences from GenBank with accession numbers AA142913, D13626, N22015, N54841, N69507, D00408, AA129757, N22479, N98464, and W90146. AA142913 is from cDNA from an adult uterus, N22015 is from cDNA from normal fetal cochlea (ear), D13636 is from randomly sampled cDNA clones from human immature myeloid cell line KG-1, N54841 is from cDNA from male fetal liver and spleen, N69507 is from cDNA from normal fetal cochlea, D00408 is from mRNA from human fetal liver, AA129757 is from cDNA from pregnant human uterus, N22479 is from cDNA from normal fetal cochlea, N98464 is from human senescent fibroblast, and W90146 is from cDNA from human male fetal liver and spleen. There are millions of sequences in the world with a small portion actually available in public databases, such as GenBank. A microarray type of invention that involves a multitude of sequences that appear to be randomly selected with no previously known function or association with cancer that merely come from normal, fetal organs; pregnant uterus; or fibroblasts (as is the case with the elected sequences) do not appear to be enabling for screening chemical compounds for anti-neoplastic activity. The quantity of experimentation required to verify that these sequences represent valid predictors of screening chemical compounds for anti-neoplastic activity appears to be undue. Due to undue experimentation required, the lack of guidance directed to verifying such sequences functioning as valid predictors, the lack of working examples addressing the same, the unpredictability of

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knowing if these sequences are potentially valid predictors for screening anti-neoplastic activity, and the breath of the claims; this invention is rejected due to the lack of enablement for one skilled in the art to be able to make and use the invention.

***Claims Rejected Under 35 U.S.C. § 112, Second Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of claim 52 is maintained under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claim 52 recite the phrases "cancerous cell over that in a non-cancerous cell" (lines 5-6 and 15) and "non-cancerous cell over that in a cancerous cell" (lines 6-7 and 13) which is vague and indefinite. Besides their cancerous status, it is unclear in what aspects these cells are related, such as if these cells are from the same or different type of organ tissue as well as the same or different type of organism which would aid in determining test relevancy. Clarification of the metes and bounds of these phrases is requested. This rejection is maintained from the previous office action.

Applicants stated that they amended the claims to recite the comparison is for cells of the same tissue type. While such amending was performed for claim 1, it was not performed in claim 52.



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***Conclusion***

No claim is allowed.

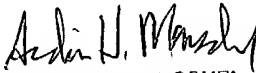
Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR §1.6(d)). The CM1 Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Smith, whose telephone number is (703) 308-6043. The examiner can normally be reached Monday through Thursday from 8 A.M. to 6:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner Tina Plunkett whose telephone number is (703) 305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

December 29, 2003

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER